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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO.           | CONFIRMATION NO.       |
|--|-------------|-------------------------|-------------------------------|------------------------|
| 10/570,824   | 10/31/2006  | Bakulesh Mafatal Khamar | 574152000700                  | 7709                   |
| 7278   | 7590        | 04/01/2009              |                               |                        |
| DARBY & DARBY P.C.<br>P.O. BOX 770<br>Church Street Station<br>New York, NY 10008-0770 |             |                         | EXAMINER<br>COPPINS, JANET L. |                        |
|  |             |                         | ART UNIT<br>1626              | PAPER NUMBER           |
|  |             |                         | MAIL DATE<br>04/01/2009       | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/570,824

**Applicant(s)**

KHAMAR ET AL.

**Examiner**

JANET L. COPPINS

**Art Unit**

1626

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 17, 22 and 23 is/are rejected.
- 7) ☒ Claim(s) 2-16, 18-21 and 24-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-27 are currently pending in the instant application.

***Priority***

2. The instant application is a 371 of International Application PCT/IB2004/002879.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 17, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claim 1 is rejected as being indefinite for reciting “an organic solvent (A),” “an organic solvent (B)” and “an organic solvent (C)” however, Applicants have failed to define (A), (B), or (C) within the claim itself. Therefore it is unclear from the claim itself what solvents Applicants are intending to recite.

(b) Claim 17 is rejected under 35 U.S.C. 112, first paragraph as being an *improper product-use* claim. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth below, one skilled in the art clearly would not know how to use the claimed invention. The claim is drafted in terms of potassium hydroxide being “used to obtain...” but, since the claims do not set forth any steps involved in the “use” (i.e. method/process), it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a “use” without any active, positive steps delimiting how this use is actually practiced.

(c) Claims 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 is generally narrative and confusing, it is unclear what Applicants are intending to encompass by the claim language. The Examiner assumes that Applicants are attempting to recite an organic solvent, which is capable of dissolving the trityl by-product, but which is also immiscible with water. Clarification is requested.

(d) Claim 23 is rejected for reciting "...and like" which is indefinite since it encompasses additional, unrecited solvents. Therefore the metes and bounds of the claim cannot be ascertained.

#### ***Claim Objections***

5. Claims 13-18 are directed to the process of "claims" 1, (plural) however it appears that each claim is only dependent on a single claim, i.e. claim 1. Appropriate correction is requested.
6. Claims 2-16, 18-21 and 24-27 are objected to as being dependent on rejected base claims.

#### ***Conclusion***

7. In conclusion, claims 1-27 are pending in the application, claims 1, 17, 22 and 23 are rejected, and claims 2-16, 18-21 and 24-27 are objected to.

#### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JANET L. COPPINS whose telephone number is (571)272-0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Janet L. Coppins/  
Patent Examiner, Art Unit 1626  
March 28, 2009

/REI-TSANG SHIAO/  
Primary Examiner, Art Unit 1626